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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,518	09/17/2003	Theodore B. Shockley	35481-73372	4878

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BARNES & THORNBURG LLP
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INDIANAPOLIS, IN 46204

EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
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3722

MAIL DATE	DELIVERY MODE
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08/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/664,518

Applicant(s)

SHOCKLEY, THEODORE B.

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11, 12, 16, 17, 19, 21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11, 12, 16, 17, 19, 21 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The affidavit under 37 CFR 1.132 filed on July 7, 2006 is insufficient to overcome the rejection of claims 1-5,11,12,16,17,19,21 and 23-27 based upon a no evidence of long-felt need as set forth in the last Office action because: the affidavit states that the claimed subject matter solved a problem that was long standing in the art. However, there is no evidence that if a person skilled in the art, who was presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. Furthermore, it is noted on page 2, lines 7-12 of the affidavit, applicant appears to admit that it is known to others that thinner stock was/is known to jam dispensing machines, cut the hands of persons handling the tickets, and wear quicker than thicker stock paper. So, although not the preferred paper of choice for ticket usage, it appears that ordinary skilled artisans in the past have readily contemplated use of the thinner stock and, for that matter, likely produced paper of the thinner stock for ticket usage only to discover the above. Applicant appears to believe what was readily contemplated in the past by ordinary skilled artisans should be novel today simply because the stock used is simply not preferred, or now manufactured, but never admittedly ruled out. (See MPEP 716.04).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5,11,12,16,17,19 and 24, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Submission of Prior Art (ASPA) in view of McCall

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et al (6,322,667). ASPA discloses a tube and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween (see Fig. 1 Prior Art). However, ASPA does not disclose a substrate having a caliper characteristic between 5 and 8 points (1 point equals .0001 inches) and an opacity characteristic less than 98%.

McCall discloses in Figs. 10,15 and 17, paper substrate made of pulp having the caliper characteristic of 193 um (.00753 in or 7.53 points as shown in Table 15), and an opacity of 97.8% (Table 17), and having additives (col. 1, lines 28-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify ASPA's ticket with a paper substrate having a caliper of 7.53 and an opacity of 97.8% as taught by McCall for providing an alternative paper substrate.

In regards to claims 2 and 16, wherein the roll comprises 1000 or 2000 tickets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required number of tickets on the roll, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Furthermore, Applicant has failed to disclose that these values are critical to the invention.

In regards to claims 3 and 17, wherein the diameter of the roll is less than 4.5 inches or 6.5 inches, it would have been an obvious matter of design choice to provide any required dimension for the diameter of the roll, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Furthermore, Applicant has failed to disclose that these values are critical to the invention.

In regards to claims 5,11 and 12, it would have been obvious to construct the substrate paper in any desirable caliper and opacity size, since such a modification would have involved a

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mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to construct the paper substrate in any desirable caliper and opacity size, since applicant has not disclosed the criticality of having a particular opacity and caliper dimensions, and invention would function equally as well in any desirable size dimension.

4. Claims 21, 24 and 27, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes (4,270,774) in view of McCall. Barnes discloses in Fig. 2-4, a strip of stock paper defining a plurality of tickets, wherein the tickets have interconnected ends defining rows of perforations therebetween and being folded along the perforations (see Fig. 4 and col. 2, lines 2-8) to provide a layer or deck of tickets. However, Barnes does not disclose a substrate having a caliper characteristic between 5 and 8 points (1 point equals .0001 inches) and an opacity characteristic less than 98%.

McCall discloses in Figs. 10, 15 and 17, paper substrate having the caliper characteristic of 193 μm (.00753 in or 7.53 points as shown in Table 15), and an opacity of 97.8% (Table 17) and having additives (col. 1, lines 28-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barnes's tickets with a paper substrate having a caliper of 7.53 and an opacity of less than 98% as taught by McCall for providing an alternative paper substrate.

5. Claim 23, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes (4,270,774) in view of McCall, further in view of Shoemaker (6,796,487). Barnes as modified by McCall discloses a plurality of tickets comprising all the elements as claimed in claim 21, and as set forth above. However, Barnes does not disclose wherein each ticket has a marking (barcode) for triggering a light and sensor ticket counting device.

Shoemaker discloses in Fig. 3 and in col. 2, lines 40-48 wherein each ticket has a dark line (barcode shown in Fig. 3 and 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barnes's and McCall's tickets with printed indicia as taught by Shoemaker for triggering a light and sensor ticket counting device.

6. Claim 25, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes in view of McCall, further in view of Greenway (4,143,810). Barnes as modified by McCall discloses a plurality of tickets comprising all the elements as claimed in claim 24, and as set forth above. However, Barnes does not disclose wherein each ticket has no bar-code and has a dark line having a ticket counting indicia for triggering a light ticket counting device.

Greenway discloses in Fig. 5, a ticket having a dark line (col. 3, lines 33-54) having ticket counting indicia (5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barnes's and McCall's tickets with no bar codes and a dark line having machine readable indicia markings as taught by Greenway for triggering an optical sensor.

In regards to claim 25, wherein the indicia is used to trigger a light ticket counting device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the indicia of Greenway is capable of triggering an optical light ticket counting device.

7. Claim 26, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes (4,270,774) in view of McCall, further in view of Horniak (5,211,093). Barnes as

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modified by McCall discloses a plurality of tickets comprising all the elements as claimed in claims 21 and 24, and as set forth above. However, Barnes does not disclose wherein each ticket has an aperture or notch for triggering a light and sensor ticket counting device. Horniak discloses in Figs. 1, 3 and 5, and in col. 2, lines 9-22 and col. 3, lines 29-45 wherein each ticket has a notch or aperture (34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barnes's and McCall's tickets with apertures or notches as taught by Horniak for triggering a light and sensor ticket counting device.

8. Claims 28-30, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Submission of Prior Art (ASPA) in view of McCall et al (6,322,667), further in view of Wagle (4,919,758). ASPA discloses a tube and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween (see Fig. 1 Prior Art). However, ASPA does not disclose a substrate having a caliper characteristic between 5 and 8 points (1 point equals .0001 inches) and an opacity characteristic less than 98%.

McCall discloses in Figs. 10, 15 and 17, paper substrate made of pulp having the caliper characteristic of 193 um (.00753 in or 7.53 points as shown in Table 15), and an opacity of 97.8% (Table 17), and having additives (col. 1, lines 28-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify ASPA's ticket with a paper substrate having a caliper of 7.53 and an opacity of 97.8% as taught by McCall for providing an alternative paper substrate. However, ASPA as modified by McCall et al does not disclose wherein the paper substrate has starch additives for enhanced stiffness. Wagle discloses in col. 2, lines 11-52 a paper substrate in which a starch added to the pulp substrate for enhanced stiffness. Therefore, it would have been obvious to one having ordinary

skill in the art at the time the invention was made to modify ASPA's ticket substrate with a starch additive as taught by Wagle for providing paper substrate having enhanced stiffness.

Response to Arguments

9. Applicant's arguments filed 13 July 2007 have been fully considered but they are not persuasive.

10. In response to applicant's argument that neither the ASPA or the McCall references teach or suggest providing "tickets from a caliper characteristic between 5 and 8 points", the examiner submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Webster's Dictionary defines "ticket" as "a slip, card or label substrate recording a transaction or undertaking or giving instructions." In its broadest sense, it is basically a substrate having indicia for a particular purpose. The ASPA reference is cited for disclosing a plurality of tickets wrapped around a tube, wherein the tickets have interconnected ends defining rows of perforations there between (see Fig. 1 of Prior Art). However, ASPA does not disclose a substrate having a caliper characteristic between 5 and 8 points (1 point = .0001 inches) and an opacity characteristic less than 98%. It is noted in the applicant's affidavit filed July 7, 2006, on page 2, lines 7-12, applicant appears to admit that it is known to others that thinner stock was/is known to jam dispensing machines, cut the hands of persons handling the tickets, and wear quicker than thicker stock paper. So, although not the preferred paper of choice for ticket usage, it appears that ordinary skilled artisans in the past have readily contemplated use of the thinner stock and; for that matter, likely produced paper of the thinner stock for ticket usage only to discover the above. Applicant appears to believe what was readily contemplated in the past by

ordinary skilled artisans should be novel today simply because the stock used is simply not preferred, or now manufactured, but never admittedly ruled out.

In any event, attention is directed to the McCall et al reference, which discloses in col. 14 (lines 57-65), col. 15 (lines 10-27), col. 17 (Table 15 for Physical Properties), and col. 18 (Table 17 for Optical Properties), that for a given type of air-dried paper, the caliper was listed as 188um (.0073 inches or 7.3 points), and 193um (.007527 inches or 7.53 points). In Table 17, for the same type of paper, the opacity was also listed for an air-dried paper to be 98.1% and 97.8%. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify ASPA's ticket with paper material characteristic of a 7.53 point caliper and a 97.8% caliper (i.e. a caliper less than 98%) as taught by McCall or, for that matter, any of a large variety of papers for providing an alternative paper substrate material.

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well within the knowledge generally available to one of ordinary skill in the art to select a substrate with particular set of construction/performance characteristics on the basis of its suitability for the intended use as a matter of obvious design choice.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT

Examiner

17 August 2007


MONICA CARTER
SUPERVISORY PATENT EXAMINER